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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

740819-416

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Application Number

09/744,595

Filed

01/26/2001

First Named Inventor

Kojiro OKAMOTO et al.

Art Unit

2627

Examiner

J.L. Ortiz Criado

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record. 28,290
Registration number _____
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Thomas W. Cole
Signature

Thomas W. Cole
Typed or printed name

202-585-8000
Telephone number

May 9, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No. 740819-416

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Confirmation No. 1644
Kojiro OKAMOTO et al.) Group Art Unit: 2627
Application No. 09/744,595) Examiner: J.L. Ortiz Criado
Filed: January 26, 2001)
For: REPRODUCING APPARATUS AND) Date: May 9, 2006
RECORDING MEDIUM)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Pre-Appeal Brief request for review from the rejection set forth in the Advisory Action dated April 6, 2006. Claim 29 has been twice rejected and a Notice of Appeal and Petition for Extension of Time are timely filed concurrently herewith. Accordingly, this Pre-Appeal Brief Request For Review is being timely filed and should be considered. Any fees required for extensions of time and any fees for the net addition of claims are hereby authorized to be charged to Deposit Account No. 19-2380 (740819-416).

REMARKS

I. Introduction – The Examiner Has Failed To Demonstrate A Motivation, Teaching, or Incentive To Combine the References Cited In His Sec. 103 Rejection

Claim 29 stands rejected under Section 103 over the combination of (1) Applicant's admitted prior art in pages 1 and 2 of the present specification; (2) Lokhoff USP 5,060,219 and (3) Timmermans USP 5,930,210. Applicants' attorney respectfully requests the Examiner to reconsider the Section 103 rejection as there is simply no motivation, teaching or incentive for a person of ordinary skill in the art to combine the various features of these references into the invention recited in claim 29.

A. Summary of the Sole Pending Claim 29

Claim 29 specifically recites a reproducing system for reproducing information in a disk-shaped writable recording medium, comprising the combination of (1) a recording medium having both primary and secondary recording regions which wobble at first and second pitches, wherein the secondary recording region includes a signal representative of primary control information that includes invalid key information for inhibiting reproduction of main data encrypted in the primary recording region, and (2) a reproducing apparatus that includes a pickup for reading a digital signal from the medium, a means for shifting the pickup, a means for distinguishing if a reproduction location of the recording medium is a track which wobbles at the first pitch or a track which wobbles at the second pitch, and

“a system controller connected to said pickup, said shifting means and said distinguishing means wherein, at a time when said reproducing apparatus is initially actuated to reproduce said data signal from a track, said controller determines whether such track wobbles at said first pitch, and if so, shifts said pickup until said track wobbles at said second pitch, whereupon said primary control information in said secondary recording region is first reproduced, and the reproduction of main data encrypted in said primary recording region by using secondary control information recorded in said primary recording region is inhibited by the invalid key information item included in said primary control information in said secondary recording region.” (Emphasis added)

B. Claim 29 is Patentable over Each of the Cited References

As recognized by the Examiner in the Office Action mailed January 17, 2006, the admitted prior art neither discloses nor suggests a disk-shaped recording medium having primary and secondary recording regions wherein the primary recording region has a track which wobbles at a first pitch and a secondary recording region has a track which wobbles at a second pitch different from the first pitch. Even more importantly, the admitted prior art does not recognize the problem that the invention solves, i.e., the prevention of a reproducing apparatus from locating and reproducing a key code such as a decryption code in a primary recording region prior to locating and operating on the basis of an invalid key code located in a secondary recording region of an R disk. For all these reasons, claim 29 is clearly patentable over the admitted prior art, taken singly.

Claim 29 is further patentable over the Lokhoff '219 patent, albeit for different reasons. The Lokhoff '219 patent discloses a recording system comprising a record carrier and a recording apparatus. The record carrier is provided with control information that informs the recording apparatus of the type of information that can be recorded on it (see column 5, lines 20 through 28). The control information will not allow the recording apparatus to record on the record carrier without a positive signal indicating that the data to be recorded is of the type that may be properly recorded (see column 5, lines 29 through 43). Because this system operates by initially preventing the recordation of selected types of data on the record carrier, it neither discloses nor suggests the recited disk-shaped writable recording medium having primary and secondary recording regions, wherein "said primary control information in said secondary recording region includes an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region by using secondary control information recorded in said primary recording region,..." To the contrary, the control information in the record carrier of the '219 patent prevents the recordation of selected types of data in the primary recording region from occurring at all. Hence, there is no disclosure, nor any need for the recited "invalid key information item for inhibiting the reproduction of main data encrypted in the primary recording region by using secondary control information recorded in said primary recording region, ..." In the '219 patent, such "secondary control information" would not occur at all. Secondly, there is no disclosure or suggestion of a system controller which detects the pitches of the track wobbles such that the pickup of the reproducing apparatus is first shifted over the secondary recording

region “whereupon said primary control information [i.e., said invalid key information] is first reproduced, and the reproduction of main data encrypted in said primary recording region is inhibited by the invalid key information...” For all these reasons, claim 29 is clearly invalid over the ‘219 patent, taken singly.

The Timmermans ‘210 patent likewise neither discloses nor suggests the reproducing system specifically recited in claim 29. All this patent discloses is a system for recovering information from a record carrier, in which the information on the record carrier is recorded by way of variations of two different physical parameters, such that the recordation of information recorded via the second physical parameter is not copied by a conventional copy machine:

“due to the fact that a bit copying machine usually only copies the variations of the first physical parameter (which variations represent the information recorded) the variations in the second physical parameter are not copied. Consequently the special disk cannot be copied by the usual type of bit copying machines.” (See column 2, lines 3 - 8.)

Accordingly, the playback apparatus for the system disclosed in the ‘210 patent has a detection circuit 61 that seeks out information recorded via the second physical parameter (which may be a radial wobble) before information recovery is enabled. As set forth in column 6, line 53 - 56. “this means that information recorded on a record carrier without a radial wobble with said predetermined frequency cannot be recovered.” As such, the Timmermans ‘210 patent actually teaches against the recited, disk-shaped recording medium having primary and secondary recording regions, wherein the second recording regions has a track which wobbles at a second pitch, and wherein primary control information in the secondary recording regions “includes an invalid key information item for inhibiting reproduction of main data encrypted in said primary recording region by using secondary control information recorded in said primary recording region,..” To the contrary, the information recorded via the radial wobble in Timmermans always includes a valid key code information. Hence claim 29 is clearly patentable over the Timmermans ‘210 patent, taken singly.

II. Conclusion – There Is No Motivation, Teaching or Incentive To Combine The References Into The Invention Defined In Claim 29

These references are not properly combinable into the invention defined in claim 29. The admitted prior art only teaches the use of R disks having primary and secondary recording regions, wherein the secondary region includes invalid key information. The Lokhoff '219 patent discloses a record carrier having pre-recorded control information that limits the type of information that may be recorded on a primary recording region of the carrier. Hence, the teachings of the Lokhoff '219 patent obviate the need for pre-recording invalid key information, as information not specifically approved by the control information is never recorded in the first place. The Timmermans '210 patent discloses a record carrier wherein valid key information is pre-recorded via a different physical parameter than information recorded on the balance of the carrier. Hence, the teachings of the Timmermans '210 patent also obviate the need for pre-recording invalid key information, as the valid key information cannot be copied by a standard bit copying machine since the valid key information is recorded via a different physical parameter.

In short, there is simply no teaching, suggestion or motivation within the references themselves to combine the various features disclosed therein in the manner recited in claim 29. To the contrary, the teachings of the admitted prior art, and the Lokhoff '219 and Timmermans '210 patents are fundamentally inconsistent with one another. While the Examiner recognizes the necessity of finding such a motivation, on page 10 of the Office Action, he fails to find it in the references themselves, and instead relies upon the teachings in the applicants own specification for the requisite teachings, suggestions and motivations to combine these references. While Applicants admit that disks are known having primary recording regions and secondary recording regions, wherein the secondary recording region includes invalid key information, applicants do not admit that there is any recognition in the prior art as to the problem that may result from such a design; i.e., the reproduction of encrypted, copyrighted material as a result of (1) the copying of a valid decryption key along with the encrypted information onto an R disk, and (2) the possibility that a conventional DVD reproducing apparatus will locate the recorded decryption information, and act on it, prior to locating the pre-recorded, invalid key information located in the secondary recorded region of the R disk. Without the recognition of the upper mentioned problem, there is simply no incentive, motivation or teaching in the prior art to combine the elements of the

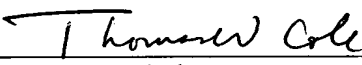
admitted prior art, and the Lokhoff '219 and the Timmermans '210 patent were to arrive at the invention defined in claim 29. As such, the facts of the instant case parallel those of *In re Spinnoble*, 160 USPQ 237, 243 (CCPA 1969), which held that

“it should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is *part* of the ‘subject matter as a whole’ which should always be considered when considering the obviousness of an invention under 35 USC Section 103...The court must be ever alert not to read obviousness into an invention on the basis of an applicants own statements; that is, we must view the prior art without reading into that art Appellant’s teachings.”

Applicants submit that without a recognition of the problem that the instant invention solves, that there is simply no incentive, teaching or motivation for the Examiner to combine the references in such a way as to arrive at the invention recited in claim 29. And as such a teaching, motivation or incentive is present only in Applicants’ own specification, applicants submit that the rejection of claim 29 under 35 USC §103 should be reconsidered and withdrawn.

The Commissioner is authorized to charge any overage or shortage of fees connected with filing of this Amendment to Deposit Account No. 19-2380.

Respectfully submitted,



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